

## **REMARKS**

### **STATUS OF THE CLAIMS**

Claims 1-33 were pending in this application. Claims 16-24 and 26-32 have been rejected. Claims 25 and 33 are objected to. Claims 1-15 have been withdrawn from consideration. Claims 16 and 26 have been amended. Following entry of the amendments, claims 16-33 will be pending and at issue.

### **ALLOWABLE SUBJECT MATTER**

The Applicants acknowledge with appreciation the Examiner's statement that claims 25 and 33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form.

### **SUPPORT FOR AMENDMENTS TO THE CLAIMS**

Claims 16 and 26 are amended to correct typographical errors. The amendments to the claims therefore add no new matter.

### **SUPPORT FOR AMENDMENTS TO THE SPECIFICATION**

The language of the Abstract of the Disclosure has been revised to remove the term "the invention," per the Examiner's suggestion. The Applicants thank the Examiner for pointing out this inadvertent error.

### **ELECTION/RESTRICTION REQUIREMENT**

Pursuant to the restriction requirement made final and election of claims 16-33, the Applicants withdraw claims 1-15 with entry of this amendment. The Applicants reserve the right to file subsequent applications claiming the canceled subject matter. In addition, the claim cancellations should not be construed as abandonment or agreement with the Examiner's position in the Office Action.

### **IDS**

The Applicants note with appreciation the Examiner's thorough consideration of the references cited in the IDS (Form 1449) submitted on July 16, 2004.

## REJECTIONS UNDER 35 U.S.C. § 103

Claims 16-24 and 26-32 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Chen (6,473,313). The Applicants traverse this ground of rejection.

Three requirements must be met for a prima facie case of obviousness. First, the prior art references must teach all the limitations of the claims. Second, there must be a motivation to modify the reference or combine the teachings to produce the claimed invention. Third, a reasonable expectation of success is required.

The cited prior art references do not teach all of the elements of the claims. The Examiner stated that Chen discloses “securing the computer component (50) to the mounting apparatus (10) by releasably engaging the computer component (50) with a release member (16)(14)(12) of the mounting apparatus (10) without the use of the tool.” The Applicants respectfully disagree. Nowhere does Chen disclose “engaging the computer component with a release member of the mounting apparatus without the use of the tool.” The Examiner points to elements 16, 14, and 12 in the Chen disclosure that the Examiner finds to be a “release member.” Chen described element 14 to be an “operating section,” element 16 to be an “elastic section,” and element 12 to be an “engaging section” (Col. 2, lines 20-23). However, none of these elements *engage* the data storage device shown in Chen. In fact, these elements are a part of the “locating plate (10)” that is positioned against the “bracket (26)” on a side opposite the data storage device. *See Figures 1 and 2.* The only element that could possibly engage the data storage device in any manner is the element 22, the “latch” that the Examiner refers to as the “guide pin.” It is impossible under this configuration of the device disclosed in Chen for the elements that the Examiner refers to as the “release member” (elements 16, 14, and 12) to engage the data storage device without substantial redesigning of the Chen device. Thus, it would not have been obvious to one of ordinary skill in the art the use the Chen “locating plate” according to the method steps of the independent claim. Furthermore, there can be no “releasably engaging” in Chen if the elements 16, 14, and 12 do not even engage the data storage device.

While element 12 in Chen is referred to as an “engaging element,” it is shown to “engage” the side panel of the “bracket (26)” that separates the data storage device and the engaging element (12), rather than engaging the data storage device itself. *See Figures 1 and 2.* In fact, Chen is quite specific about the “engaging” function of the “engaging element (12).” Chen states that the “stopping tab 34 engages with an end portion of the engaging section 12 remote from the elastic section 16” (Col. 3, lines 26-29). Chen further clarifies that the purpose of this is to protect the elastic section 16 from “excessive deformation.” *Id.*

In addition, the Chen reference does not disclose “securing the computer component...without the use of the tool.” The only way that the data storage device in Chen can be “secured” to the “enclosure” and to the “locating plate (10)” is by sliding a “screw (52)” into a “screw hole” in the data storage device. *See Figure 2, Col. 2, lines 15-18.* In fact, Chen specifically refers to a method step where the “screw 52 is engaged in the screw hole... of the data storage device 50” and the screw is used for “sliding in the groove 42” so that the device is “pushed until the hole 54 opposes the latch 22” (Col. 3, lines 7-15). A tool must be used for inserting the screw into the screw hole. The element 10 that the Examiner refers to as mounting apparatus thus cannot be used to “mount” the data storage device without insertion of this screw. In fact, while Chen discusses the benefits of not using a tool, Chen states in general that “installation and removal of screws *requires* a tool” (emphasis added; Col. 1, lines 13-14).

The Examiner further states that the Chen reference discloses “connecting a mounting apparatus (10) to a support member (unlabeled) (defined as the left hand wall of the enclosure (26)) of an enclosure (26) by attaching at least one fastener (18) of the mounting apparatus (10) to the enclosure (26) without the use of a tool.” Applicants again respectfully disagree. First, the element 26 disclosed in the Chen reference is a “bracket (26),” and not a computer enclosure into which computer components are mounted, as described by the specification and claims of the present invention. *See Figures 1 and 2.* The “locating plate (10)” element that the Examiner calls the mounting apparatus is attached to the bracket, but not to anything referred to as a computer enclosure or to a support member. *See Id.* There is also no mention of whether or not

this bracket is actually used in a computer enclosure, or how such a bracket would even be attached to the enclosure. Presumably, a tool would have to be used. Second, it is unclear as to where the Examiner is saying that the Chen specification defines anything as a support member of a computer enclosure. The Examiner only points to a side wall of the “bracket,” but not a “support member” of a computer enclosure.

Accordingly, the Chen does not include or make obvious all of the elements of claim 16, and thus cannot render the claim obvious. Furthermore, claims 17-24 depend from claim 16 and thus these claims cannot be rendered obvious by Chen either.

The Chen reference also does not teach all of the elements of independent claim 26. The Examiner stated that Chen discloses “manipulation of a release plunger (14) which is part of release member (12)(14)(16) disengages the computer component (50) without the use of the tool.” The Applicants again respectfully disagree. Nowhere does Chen disclose a “release plunger.” Element 14 that the Examiner points to is an “operating section” that does not take the form of a “plunger” in any way. In fact, Chen only vaguely described element 14 as being a “perpendicularly bent” section of the locating plate 10 (Col. 2, lines 26-28). In addition, Chen also fails to disclose a “release member,” as already described at length above. The Examiner points to elements 16, 14, and 12 in the Chen disclosure that the Examiner found to be a “release member,” but none of these elements *engage* the data storage device of Chen, and so cannot disengage the data storage device. Thus, Chen fails to disclose “unsecuring the computer component from a mounting apparatus that is adapted to receive computer components by manipulating a release member of the mounting apparatus to disengage the computer component without the use of a tool.”

In addition, the Chen reference does not disclose unsecuring without the use of a tool. First, Chen fails to disclose how any unsecuring might even be accomplished. Second, as described above, the only way that the data storage device in Chen can be “unsecured” from the “enclosure” and from the “locating plate (10)” is by sliding a “screw (52)” in the groove 42 of the bracket. *See Figure 2, Col. 2, lines 15-18, Col. 3, lines 7-15.* A tool must be used for inserting

the screw into the screw hole. Thus, the element 10 that the Examiner refers to as a mounting apparatus cannot be used to “mount” the data storage device without insertion of this screw.

Additionally, the Chen reference fails to disclose “disconnecting the mounting apparatus from a support member of the enclosure by detaching at least one fastener of the mounting apparatus from the enclosure without the use of the tool.” As explained above, the element 26 that the Examiner calls an “enclosure” is actually referred to as a “bracket (26),” to which the locating plate (10) is attached. *See Figures 1 and 2.* The Chen reference also fails to disclose a support member of a computer enclosure.

Furthermore, the Examiner specifically admitted that Chen does not disclose the “method steps of installing the computer component into the enclosure.” However, Chen also fails to disclose all of the structural elements, as explained above. In addition, the structures that Chen discloses would not even be capable of being used to perform the method steps of the present invention. Thus, it would not have been obvious to one of ordinary skill in the relevant art to apply the method steps of the present invention to the Chen device.

Accordingly, Chen does not include or make obvious all of the elements of claim 26, and thus cannot render the claim obvious. Furthermore, claims 27-32 depend from claim 26 and thus these claims cannot be rendered obvious by Chen either.

The cited art does not teach or provide a motivation to modify the teachings to produce the claimed invention. Nowhere does Chen suggest that his “locating plate (10)” ought to be modified to allow the elements 12, 14, and 16 to “engage” or to “disengage” the data storage device. Furthermore, Chen does not suggest using his “locating plate (10)” to engage or disengage a computer component in a manner that does not require a tool. Additionally, Chen does not suggest that the “locating plate (10)” ought to be modified to be mounted in a computer enclosure or on a support member. One of ordinary skill in the relevant art would not select the elements described by the Examiner to create the present invention.

The Examiner must show “reasons that the skilled artisan, confronted with the same problem as the inventor, and with no knowledge of the claimed invention, would select the

elements from the cited prior art reference for combination in the manner claimed.” *In re Rouffet*, 47 USPQ2d at 1458, 1453 (Fed. Cir. 1998). Thus, the motivation to modify or combine must be established with particularity, and the Examiner has not shown this in the present case. In the absence of some teaching or suggestion in the cited references concerning the method of the present invention, the Examiner has presented no more than an improper hindsight reconstruction of the present invention.

In conclusion, Chen fails to disclose each and every element of the claims and fails to provide a motivation or suggestion to modify the teaching to produce the claimed invention. Therefore, a *prima facie* case of obviousness is not made. Withdrawal of this ground of rejection of claims 16-24 and 26-32 is respectfully requested.

## CONCLUSION

Withdrawal of the pending rejections and reconsideration of the claims are respectfully requested, and a notice of allowance is earnestly solicited. If the Examiner has any questions concerning this Response, the Examiner is invited to telephone Applicant's representative at (650) 335-7185.

Respectfully submitted,  
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